

REMARKS

The present application was filed on January 31, 2001 with claims 1-48. Claims 1, 15 and 32 are independent claims. In the final Office Action, the Examiner: (i) rejected claims 1-12, 14-26, 28-30, 32-43 and 45-47 under 35 U.S.C. §102(b) as being anticipated by a newly-cited reference, namely, German Patent No. DE4435565A1 to Burkhardt (hereinafter "Burkhardt"); (ii) rejected claims 13, 27 and 44 under 35 U.S.C. §103(a) as being unpatentable over Burkhardt in view of U.S. Patent No. 5,648,789 to Beadles et al. (hereinafter "Beadles"); and (iii) rejected claims 31 and 48 under 35 U.S.C. §103(a) as being unpatentable over Burkhardt.

In this response, Applicants traverse the §102(b) and §103(a) rejections for at least the following reasons.

First, Applicants point out that the copy of Burkhardt provided with the Office Action is entirely in the German language. An English language abstract from Derwent Information Ltd. (hereinafter "the Derwent Abstract") was provided in the Office Action along with the German language patent document. M.P.E.P. §706.02 addresses reliance on abstracts and foreign language documents in support of a rejection. As stated therein:

When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document. Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished). To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection. The rationale for this is several-fold. It is not uncommon for a full text document to reveal that the document fully anticipates an invention that the abstract renders obvious at best. The converse may also be true, that the full text document will include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection. An abstract can have a different effective publication date than the full text document. Because all patentability determinations are fact dependent, obtaining and considering full text documents at the

earliest practicable time in the examination process will yield the fullest available set of facts upon which to determine patentability, thereby improving quality and reducing pendency. When both the abstract and the underlying document qualify as prior art, the underlying document should normally be used to support a rejection. In limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document. In such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action. (Underlining added for emphasis).

Applicants therefore assert that the record is not clear whether the Office Action relies on the Derwent Abstract or on Burkhardt itself. If the Office Action is relying on Burkhardt itself, M.P.E.P. §706.02 requires that a translation of the entire document be provided by the Examiner so that the record is clear as to the precise facts the Examiner is relying upon in support of the rejection. Further, if the Office Action considers the Derwent Abstract to be prior art, and is also relying on the Derwent Abstract, M.P.E.P. §706.02 requires that the rejection be non-final. Applicants assert that none of these requirements have been met by the present Office Action and, therefore, the present rejection based on Burkhardt is improper..

With regard to the issue of whether claims 1-12, 14-26, 28-30, 32-43 and 45-47 are anticipated under 35 U.S.C. §102(b) by Burkhardt, it is believed that Burkhardt, based at least on a review of the Derwent Abstract, fails to teach or suggest all of the limitations in claims 1-12, 14-26, 28-30, 32-43 and 45-47, for at least the reasons presented below.

It is well-established law that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Applicants assert that the §102(b) rejection does not meet this basic legal requirement, as will be explained below.

The present invention, for example, as recited in independent claim 1, recites a method of processing a signal wherein at least a portion of the signal includes one or more closed captions representing audio content associated with a program whose visual content is being viewed by a user. The method comprises the steps of: obtaining, directly from an originating source, the signal including the one or more closed captions in a portable processing device; autonomously processing

the signal in the portable processing device so as to generate a display signal representative of the one or more closed captions in the obtained signal; and providing the display signal from the portable processing device to a portable display, operatively coupled to the device, for presentation to the user so that the user may view the visual content of the program and view the one or more closed captions in accordance with the portable display. Independent claims 15 and 32 recite similar limitations.

Further, as illustratively explained in the present specification between page 3, line 4, through page 7, line 8:

Accordingly, with a closed caption receiving device according to the invention, a person may come to a place where a program is being broadcasted on television without closed captioning services. The person may then set the device to the same channel as the program being broadcasted and see closed captions associated with the audio content of the program on the local wearable display system. Preferably, rather than transmitting all the broadcast information, the receiving device transmits only the closed captions for display on the local wearable display system. Thus, the user is able to simultaneously look at the television screen while reading the closed captions. However, it is to be appreciated that content other than the closed captions may be extracted and displayed on the local wearable display system, if so desired.

In yet another illustrative aspect, the present invention provides a portable and universal closed caption receiving device for receiving a signal including closed captions from a transcription service while the user views a program on a video/audio content display system in which no closed captioning capability is available such as, for example, one that may be associated with a personal computer or a movie theater. Again, in this case, the closed caption receiving device is used in conjunction with a separate display system carried by the user such as, for example, a wearable head mounted display. The closed captioning device receives the transcription services including closed captions from the transcription service provider while the user watches a movie or some other program in a theater or on a computer (e.g., a digital video disc) in which no closed captioning capability is available. In accordance with the invention, when a person sees that there is a movie being displayed on a computer screen or in a movie theater, the person may contact the transcription service and request a transcription of the program by name. The transcription service transmits the closed captions synchronously with events in the program. Several methods may be employed to synchronize the closed caption with the events in the program. For example, an operator associated with the service may be able to listen to the dialogue from the program so as to ensure that the transcription coincides with the program. Again, the closed captions, themselves, may be transmitted through a wireless network to the receiving device which then provides them to the user's wireless wearable head mounted display. Of course, the connection may be hardwired. In any case, this allows the person to look at the computer or

theater screen through the wearable display and see the program while reading the captions on the wearable display comfortably.

It is to be appreciated that a stenographic service may be used in conjunction with the invention to type what is being broadcasted or shown in those cases when closed captioning is not readily available, e.g., live broadcasts. Thus, for instance, rather than requesting a prestored transcription, the user may request a real-time stenographic transcription of a live program.

Burkhardt appears to disclose a portable video text or teletext decoder system, as disclosed by the Derwent Abstract. Further, as the Derwent Abstract suggests "[t]he system functions exclusively as a video text receiver, processing and displaying data, and does not function as a TV set [and] is particularly appropriate for stock exchange reporting."

However, Burkhardt does not appear to disclose "processing a signal wherein at least a portion of the signal includes one or more closed captions representing audio content associated with a program whose visual content is being viewed by a user, as in the independent claims of the invention. Nor does Burkhardt appear to disclose generating a display signal . . . "so that the user may view the visual content of the program and view the one or more closed captions in accordance with the portable display," as in the independent claims of the invention.

That is, Burkhardt appears to have nothing to do with closed captions, and appears to have anything to do with text representing audio content associated with a program whose visual content is being viewed by a user. As the Derwent Abstract suggests, the system handles display of stock exchange reporting data in the form of text. This is significantly different than closed captions representing audio content associated with a program whose visual content is being viewed by a user.

Also, there is no indication that Burkhardt generates a display signal . . . "so that the user may view the visual content of the program and view the one or more closed captions in accordance with the portable display," as in the claimed invention. Recall, as illustratively explained above, in accordance with the invention, the user is advantageously able to simultaneously look at a television screen while reading the closed captions.

At least with respect to independent claim 32, the Office Action appears to suggest that Burkhardt inherently includes a closed caption service system. According to the Court of Customs and Patent Appeals (CCPA), "[i]nherency does not mean that a thing might be done, or that it might

happen, ...; but it must be disclosed, if inherency is claimed, that the thing will necessarily happen.” *In re Draeger et al.*, 150 F.2d 572, 574 (CCPA 1945) (emphasis supplied). Furthermore, well-settled law “requires that inherency may not be established by possibilities and probabilities [t]he evidence must show that the inherency is necessary and inevitable.” *Interchemical Corp. v. Watson*, 145 F.Supp. 179, 182, 111 USPQ 78, 79 (D. D.C. 1956) (emphasis supplied), *aff’d*, 251 F.2d 390, 116 USPQ 119 (D.C. Cir. 1958). The Office Action makes no showing whatsoever that a closed caption service system necessarily and inevitably flows from the Burkhardt system.

For at least the above reasons, Applicants assert that independent claims 1, 15 and 32 are patentable over the cited reference.

Regarding claims 2-12, 14, 16-26, 28-30, 33-43 and 45-47, Applicants assert that such claims are patentable over the cited reference not only due to their respective dependence on independent claims 1, 15 and 32, but also because such claims recite patentable subject matter in their own right.

In rejecting the features of such dependent claims (with the exception of claims 11, 14, 29, 30, 46 and 47 where it is alleged that Burkhardt “shows” something), the Office Action does not refer to the Derwent Abstract or Burkhardt itself. Rather, the Office Action seems to state alleged assumptions about teletext systems and about closed captioning systems in support of the rejections, without making clear where support for such assumptions may be found. This is improper.

For at least these reasons, Applicants assert that dependent claims 2-12, 14, 16-26, 28-30, 33-43 and 45-47 are patentable over the cited reference.

Regarding the §103(a) rejection of claims 13, 27 and 44 based on a combination of Burkhardt and Beadles, Applicants assert that such a combination fails to establish a prima facie case of obviousness as specified in M.P.E.P. §2143.

As set forth therein, M.P.E.P. §2143 states that three requirements must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited combination must teach or suggest all the claim limitations. While it is sufficient to show that a prima facie case of obviousness has not been established by showing that one of the requirements has not been met, Applicants respectfully believe that none of the requirements have been met.

First, there is a clear lack of motivation to combine the references. For at least this reason, a prima facie case of obviousness has not been established. Burkhardt appears to be directed to a teletext system, while Beadles discloses a wearable caption display. That is, the teachings in each reference are directed to completely different environments; one (Burkhardt) toward a teletext environment, the other (Beadles) toward a caption display environment. However, other than a very general and conclusory statement in the final Office Action, there is nothing in the two references that reasonably suggests why one would actually combine the teachings of these two references.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344.

In the final Office Action at page 4, the Examiner provides the following statement to prove motivation to combine Burkhardt and Beadles, with emphasis supplied: “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to adapt the head mounted display in Burkhardt [sic] so that the hearing impaired people can simultaneously watch both the closed caption and the pictures.”

Applicants submit that this statement is based on the type of “subjective belief and unknown authority” that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner fails to identify any objective evidence of record which supports the proposed combination.

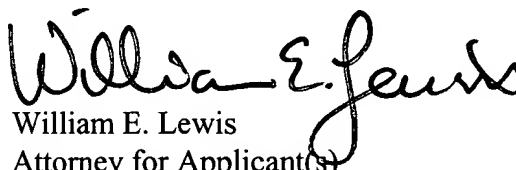
Second, Applicants assert that there is no reasonable expectation of success in achieving the present invention through a combination of Burkhardt and Beadles. For at least this reason, a prima facie case of obviousness has not been established. Applicants do not believe that the two references are combinable since it is not clear how one would combine them. No guidance is provide in the present Office Action.

Third, Applicants assert that the combination of Burkhardt and Beadles fails to teach or suggest all of the claim limitations of the subject claims. For at least this reason, a prima facie case of obviousness has not been established. Again, assuming arguendo that the references could be properly combined, which for at least the reasons above it is believed that they can not be properly combined, the combination fails to teach or suggest all claim elements in the subject dependent claims. By way of example, see the deficiencies described above with regard to Burkhardt. Beadles does not remedy these deficiencies.

Regarding the §103(a) rejection of claims 31 and 48 based on Burkhardt alone, Applicants assert that it would not be obvious to include a voice recognition system in Burkhardt since Burkhardt appears to have nothing to do with audio content. Thus, Applicants challenge the taking of Official Notice and request a reference be cited that properly supports the Examiner's position.

In view of the above, Applicants believe that claims 1-48 are in condition for allowance, and respectfully request withdrawal of the §102(b) and §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William E. Lewis". The signature is fluid and cursive, with the first name "William" being the most prominent part.

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